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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,072	06/01/2001	Jules E. Gardner	P1133/20004	2291

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EXAMINER	
BECKER, SHAWN M	

ART UNIT	PAPER NUMBER
2173	4

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/872,072	GARDNER ET AL.	
	Examiner	Art Unit	
	Shawn M. Becker	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-18 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 31 December 2001 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. This application claims priority as a division of Application No. **09/723505**, filed 11/28/2000. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional application or "division." The divisional application should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application. However, this application repeats a substantial portion of prior Application No. **09/723505**, filed 11/28/2000, and adds and claims additional disclosure (i.e. page 8, the paragraph beginning on line 12) not presented in the prior application. Therefore, it may constitute a continuation-in-part of the prior application, but does not appear to be a division. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/872036. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-20 of the copending application provide substantially the same limitations as those in claims 1-18 of the instant application, except that the additional visually perceivable information is imperceivable until the cursor is located on the selected sub-area. However, claim 9 or the copending application claims that the additional visually perceivable information remains perceivable while the cursor remains on the region, implying that it becomes imperceivable, and claim 1 claims that the additional visually perceivable information is provided (displayed) when a sub-area is selected, which requires the cursor to be located on the sub-area. Therefore, it would have been obvious to one of ordinary skill in the art to keep the additional visually perceivable information imperceivable until the cursor is located over the sub-area in order for the additional visually perceivable information to draw attention by becoming perceivable when it is provided. A "banner area" is a type of primary area, and the iframe is described in claim 20 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

4. Claims 14-17 are objected to because of the following informalities: "receivable" in line 2 of claim 14 should be --perceivable--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites the limitation "the images" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 2 recites the limitation "said banner area" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 10 recites the limitation "said visually perceivable banner information" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 18 recites the limitation "said banner website" in lines 8-9 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 7, 10-14, and 18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,370,537 to Gilbert et al. (hereinafter Gilbert).

Referring to claim 1, Gilbert discloses a method for delivering information to a person having a terminal (client; Fig. 1, 108) with an associated display upon which images are visually perceivable by a person using the terminal and a cursor whose position is controllable by the person. Fig. 26 shows a website, whose content is visually perceived by the user, with banner 2600. Col. 17, lines 44-47 describes how the user may move the mouse, which controls the position of a cursor.

a) The method of Gilbert provides a display iframe upon the visual display. See col. 17, lines 12-47 and Fig. 26.

b) The method of Gilbert provides initial signals to establish a primary image area (banner) on the display iframe, the primary image area including information that is visually perceivable by the person and a sub-area of the primary image area within the display iframe. See Fig. 26, banner 2600, which shows three sub-areas (frames). Also, see col. 17, lines 40-44, which describe how the banner (primary image area) may be split into frames.

c) The method of Gilbert enables the person to control the cursor to position the cursor on the sub-area of the primary image (banner) to provide a selected sub-area, whereupon the person is automatically provided with additional visually perceivable information associated with the selected sub-area. See col. 17, lines 44-53, which describes how a mouse over an image in one of the frames causes a pop-up window (visually perceivable) to be displayed on the display, the

pop-up window provides additional visually perceivable information associated with the selected sub-area (frame).

d) The additional visually perceivable information of Gilbert is provided independently of further positioning of the cursor by the person (i.e. the pop-up/addition visually perceivable information is provided upon the mouse over, which requires no further positioning or action).

e) The respective additional visually perceivable information of Gilbert is imperceivable by the person until the cursor is located on the selected sub-area. See col. 17, lines 44-53, which describes how a mouse over an image in one of the frames causes a pop-up window (visually perceivable) to be displayed, which provides additional information associated with the selected sub-area (frame).

Referring to claim 7, the initial signals of Gilbert carry the instructions necessary for enabling the terminal to establish the additional visually perceivable information (pop-up). See col. 17, lines 25-31 and 50-54.

Referring to claims 10-11, the method of Gilbert receives the visually perceivable banner information, first identification data representative of the visually perceivable banner information, the additional visually perceivable information, and second identification data representative of additional visually perceivable information. See col. 17, lines 25-31 and 50-54, which describes how the banner information and additional information are served from an ad server, and therefore must be received by the terminal. The method of Gilbert specifies a placement of the additional visually perceivable information with respect to the visually perceivable banner information according to the first and second identification data. See Fig. 26, which shows the pop-up window (additional information) in relation to the banner.

Referring to claim 12, the method of Gilbert must build a use map in accordance with the first and second identification data to associate the appropriate pop-up window with the appropriate image (sub-area) in the banner. See col. 17, lines 44-47. Also, see col. 12, lines 20-28.

Referring to claim 13, Gilbert discloses the step of providing additional visually perceivable information comprises the steps of:

a) building a pop-up function in accordance with the additional visually perceivable information (col. 17, lines 44-47);

b) adding HTML information to the pop-up function to provide an enhanced pop-up function (col. 17, lines 47-50 and col. 12, lines 26-28); and

c) displaying the visually perceivable banner information and the additional perceivable information in accordance with the enhanced pop-up function. See col. 17, lines 40-50 and the pop-up associated with banner 2600 in Fig. 26.

Referring to claim 14, Gilbert discloses that the primary image area (banner) includes plural sub-areas (frames) associated with respective additional visually perceivable information and the step of altering associations between the sub-areas (frames) and the respective additional visually perceivable advertising message information and repeating step (b). See col. 17, lines 17-31 and 50-54, which describes how the content of the pop-up (additional visually perceivable information) and banner are determined by the ad server and may be changed by the advertiser.

Referring to claim 18, Gilbert discloses transmitting a request having request information to a server database (ad server) on a website containing stored visually perceivable information

in response to the positioning of the cursor on the selected sub-area (frame), selecting the additional visually perceivable information (pop-up window) from the stored visual information in response to the request information, and transmitting the stored visually perceivable information to the banner website. See col. 17, lines 44-54.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 2, 6, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert.

Referring to claim 2, Gilbert shows a pop-up window associated with banner 2600 in Fig. 26, which substantially crosses the lower boundary of the banner area, but Gilbert does not explicitly show the selected region where the pop-up window (visually perceivable information) is displayed is provided substantially outside the boundaries of the banner area. However, pop-up windows may be placed anywhere within a display and may comprise different sizes. As an example, see Fig. 18 or Gilbert, which shows a pop-up window (1802), provided substantially outside of the boundaries of banner area (1801). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pop-up window of Gilbert in a selected region provided substantially outside of the boundaries of the banner area, in order to prevent

covering up the banner, and reducing its visibility or to enlarge the pop-up window to draw attention to it.

Referring to claim 6, the additional visually perceivable information (pop-up) of Gilbert is imperceivable by the person until the cursor is located on the selected sub-area. See col. 17, lines 44-53, which describes how a mouse over an image in one of the frames causes a pop-up window (visually perceivable) to be displayed, which provides additional information associated with the selected sub-area (frame). The pop-up window does not have a button in the window for closing the window ('x'), and therefore is believed to remain perceivable to the person as long as the cursor remains on the selected sub-area (frame) or on the pop-up window. It is typical for a mouse over event to last as long as the mouse (cursor) remains positioned over the image associated with the mouse over. The Examiner takes Official Notice of this teaching. It would have been obvious to one of ordinary skill in the art to ensure the pop-up window of Gilbert remains open as long as the cursor remains on the selected sub-area (frame) or the pop-up window (region), because the lack of movement of the cursor indicates the user is still reading the additional information.

Referring to claim 8, the pop-up window of Gilbert (additional visually perceivable information) is displayed in a region (window) adjacent to the selected sub-area (frame). See the pop-up window over (adjacent) the banner 2600 in Fig. 26. The pop-up window does not have a button in the window for closing the window ('x'), and therefore is believed to remain perceivable to the person as long as the cursor remains on the selected sub-area (frame) or on the pop-up window. It is typical for a mouse over event to last as long as the mouse (cursor) remains positioned over the image associated with the mouse over. The Examiner takes Official Notice

of this teaching. It would have been obvious to one of ordinary skill in the art to ensure the pop-up window of Gilbert remains open as long as the cursor remains on the selected sub-area (frame) or the pop-up window (region), because the lack of movement of the cursor indicates the user is still reading the additional information.

Referring to claim 9, the additional visually perceivable information (pop-up) of Gilbert contains link information for linking the person to a further website when the person clicks on the selected region. See col. 17, lines 48-64.

15. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and U.S. Patent No. 6,496,857 to Dustin et al. (hereinafter Dustin).

Referring to claims 3-5, Gilbert discloses additional visually perceivable information in the form of a pop-up window, but Gilbert does not explicitly describe that the pop-up window contains audio information, video information, or mixed media information. However, Dustin describes a method for enhancing advertisements, which provides ads that contain audio, video, and/or mixed media information. See col. 3, lines 5-8. It would have been obvious to one of ordinary skill in the art at the time of the invention to enhance the additional visually perceivable advertising message information (pop-up window advertisements) of Gilbert such that they include audio, video, and/or mixed media information for a more affective form of advertisement as supported by Dustin.

16. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert and U.S. Patent No. 6,401,075 to Mason et al. (hereinafter Mason).

Referring to claims 15-17, Gilbert discloses that the advertisements may be customized according to a user profile or at the discretion of the advertiser (col. 17, lines 21-31), but Gilbert does not explicitly altering the associations between the sub-areas and the respective additional visually perceivable information (pop-up advertisements) in accordance with recorded performance parameters. However, Mason discloses methods of monitoring internet advertising, in which parameters (which are predetermined) representative of the advertisements (i.e. click-through) are recorded to provide recorded performance parameters, and the advertisements presented are altered in accordance with the recorded performance parameters. See col. 2, lines 39-51. Altering the advertisements in accordance with the recorded performance parameters is repeated to provide the advertiser with accurate results of the success of the advertisements. The recorded performance characters may be selected after altering the associations. See Mason at col. 4, lines 20-37 and col. 6, lines 51-65. It would have been obvious to one of ordinary skill in the art to modify the associations between the frames of the banner (sub-areas) and the pop-up window (additional visually perceivable advertising message information) of Gilbert in accordance with recorded performance parameters as taught by Mason in order to provide the advertiser with information on the success of the advertisements in the pop-up window and alter the pop-up window and banner accordingly as supported by Mason.

Conclusion

17. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach

methods of advertising through banners, methods of providing mouse over events, methods of positioning a cursor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is 703-305-7756. The examiner can normally be reached on M-Th 8:00 - 5:30 and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 703-308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smb

JOHN CABECA
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